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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/619,993	07/20/2000	Ruben G. Carbonell	5051-408CX2DV	2551

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EXAMINER

TOOMER, CEPHIA D

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 11/04/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/619,993

Applicant(s)

CARBONELL ET AL.

Examiner

Cephia D. Toomer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 1/8/02 & 2/8/02.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 15-22 and 33-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 15-22, 33-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### DETAILED ACTION

This Office action is in response to the amendment filed January 8, 2002 in which claims 23-32 were canceled; claims 33-51 were added and claim 15 was amended.

The rejection of the claims under 35 USC 112, first paragraph is withdrawn in view of the amendment to the claims.

#### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 15-18, 20, 33-37, 39, 42-46, 48 and 51 are rejected under 35 U.S.C. 102(b) as being anticipated by Gribbin (US (U.S. 5,186,974).

Gribbin teaches a coating composition comprising a film-forming agent, such as an aqueous solution of bifunctional fluoropolyethers. The bifunctional moieties include, diols, dicarboxylic acids and diesters (see abstract; col. 3, lines 43-46). Gribbin teaches that from 0.5 to 20 percent of the film-forming agent is sprayed together with a carrier gas stream. Such gas streams include carbon dioxide (see col. 3, line 59 through col. 4, lines 1-10).

Accordingly, Gribbin teaching all the material limitations of the claims, anticipates the claims..

3. Claims 19, 38 and 47 are rejected under 35 USC 103(a) as being unpatentable over Gribbin, as applied to the above claims, further in view of Piacenti (4,902,538).

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Gribbin fails to teach that the fluoropolyether of his invention has an amide anchoring group. However, Piacenti teaches this difference (see abstract (3); col. 4, line 39 through col. 5, lines 1-39). These functionalized anchoring groups include carboxylic acids, esters and amides.

It would have been obvious to one of ordinary skill in the art to have substituted the fluoropolyether containing an amide anchoring group for those fluoropolyethers of Gribbin because the substitution of art recognized equivalent is prima facie obvious.

4. Claims 21, 22, 40-41 and 49-50 are rejected under 35 U.S.C 103(a) as being unpatentable over Gribbin, as applied to the claims above, further in view of Nielsen (U.S 5,009,367).

Gribbin fails to teach that carbon dioxide is a liquid or a supercritical fluid. However, Nielsen teaches combining supercritical fluids with a coating composition and spraying this composition and Nielsen teaches that "the use of supercritical fluids as a transport medium for the manufacture of surface coating is well known". See col. 5, lines 6-10, 29-30.

It would have been obvious to one of ordinary skill in the art to substitute the supercritical fluid CO<sub>2</sub> of Nielsen for the gaseous CO<sub>2</sub> of Gribbin because Nielsen teaches that supercritical CO<sub>2</sub> may be used to transport medium for the manufacture of surface coatings, such as those of Gribbin. Also, since Nielsen teaches that supercritical fluids are gases that cannot be liquefied by an increase in pressure, but however, have a liquid-like characteristic (see col. 7, lines 27-63), it also would have been obvious to one of ordinary skill in the art to have replaced CO<sub>2</sub> gas with

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supercritical CO<sub>2</sub> because supercritical CO<sub>2</sub> because it is also a gas, but also because it is a gas that has liquid like characteristics. This teaching suggest what Applicant has done and shows that there is no criticality in using strictly liquid or gaseous CO<sub>2</sub> because supercritical CO<sub>2</sub> performs the same attendant function.

5. Applicant's arguments filed have been fully considered but they are not persuasive.

Applicant argues that the claim language "consisting essentially of" excludes water from the composition of the present invention. Applicant directs the examiner's attention to the specification wherein the statement regarding only minor amounts of cosolvents, surfactants or the like may be present in the instant composition. It is Applicant's position that this statement supports the exclusion of water from the present composition.

It is well settled that the transitional phrase "consisting essentially of" limits the scope of the claim to the specified material and those that do not materially affect the basic and novel characteristics of the claimed invention. *In re Herz* 190 USPQ 461 (CCPA 1976). As Applicant has pointed out in the specification, minor amounts of cosolvents may be present in the composition and this teaching does not exclude water, nor is there any evidence that the presence of water would affect the basic and novel characteristics of the claimed invention.

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Applicant argues that Gribbin does not teach using liquid CO<sub>2</sub> but proposes using gaseous CO<sub>2</sub> as a carrier for the aerosol, as does Nielsen with the use of supercritical CO<sub>2</sub>.

Nielsen teaches that supercritical fluids are gases that cannot be liquefied by an increase in pressure, but however, have a liquid like characteristics (see col. 7, lines 27-63). Therefore, it would have been obvious to one of ordinary skill in the art to have replace CO<sub>2</sub> gas with supercritical CO<sub>2</sub> because supercritical CO<sub>2</sub> because it is also a gas, but also because it is a gas that has liquid like characteristics. This teaching suggest what Applicant has done and that there is no criticality in using strictly liquid or gaseous CO<sub>2</sub> because supercritical CO<sub>2</sub> performs the same attendant function.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

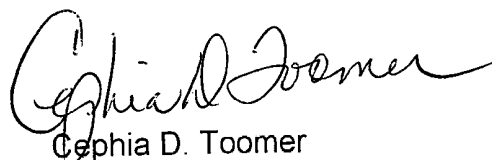
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 703-308-2509. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Cephia D. Toomer  
Primary Examiner  
Art Unit 1714

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November 2, 2002